Remarks

Applicants have thoroughly considered the Examiner's remarks in the January 2, 2008 Office Action and made final. Claims 1, 3, 4, 7-14, 16-21, 26-28, 30-32, and 49-61 are now pending.

Applicants respectfully request reconsideration of the rejections of claims 1, 3, 4, 7-14, 16-21, 26-28, 30-32, and 49-61 in view of the following remarks.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 7, 11, 16, 26, 30 and 61

Claims 1, 2, 7, 11, 16, 26, 30 and 61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,898,574 to Regan et al. ("Regan") in view of U.S. Patent No. 5,857,174 to Dugan et al. ("Dugan"). Applicants respectfully traverse this rejection for at least the following reasons.

Firstly, in the Response to Arguments section beginning on page 20 of the Final Office Action, and specifically in part (4) thereof on page 21, the Office asserts that the Regan reference is neutral on the subject of categorizing appraisers. As such, the Office appears to acquiesce with Applicants argument that Regan does not fairly teach or suggest such a feature. Indeed, on page 4 of the Final Office Action, the Office notes that Regan does not explicitly disclose categorization of appraisers as claimed. The Applicants and the Office therefore agree that the Regan reference is at best silent on this point.

Secondly, Applicants disagree with the assertions set forth on page 5 of the Final Office Action that Dugan renders categorization of appraisers obvious because Dugan discloses steps for determining an accuracy of an appraiser. In reply, Applicants submit that Dugan does *not* relate to determining an accuracy of an appraiser, but rather describes a system and method that appraisers may utilize to more accurately make real estate appraisals. This is perhaps a subtle but key distinction between the Dugan reference and the claimed invention.

The concepts of accurately determining appraisals for a selected property, as Dugan relates to, and assessing an accuracy of assessing multiple appraisers to predict their future performance on subsequent appraisals, per the present claims, are not believed to be as closely linked to one another as the Final Office Action would appear to suggest. These concepts are clearly of different character, and involve different timeframes, different perspectives, and

different persons to evaluate. For example, appraisers use the Dugan system in a forward-looking manner to generate appraisals for a property transaction, while the claimed subject matter, at least in pertinent part, looks back on such forward-looking appraisals to determine how accurate the forward-looking appraisal actually turned out to be, using an actual sales price as a basis to evaluate the accuracy of appraisers against one another. Stated another way, the Dugan system is used by an appraiser, while the claimed subject matter may be used to select an appraiser. The former does not logically commend itself to the latter.

Logically speaking, each appraiser submits his or her best forward-looking appraisal every time when asked, and an eventual sale of the property proves such best efforts to be accurate or inaccurate. The Final Office Action on page 5 appears to recognize that timely sale information for the same property involved in the transaction is typically not available, and that "most comparable" local neighborhood sales prices are typically used instead and are obvious yardsticks for measuring an appraiser's accuracy.

As those in the industry realize, however, "most comparable sales" data is as much an art as a science, and Dugan himself notes at col. 1, lines 62-67 and throughout column 2, using "comparable sales" data is fraught with drawbacks and difficulties. Since Dugan acknowledges that market price alone does not reflect the conditions of the property at the time of sale, or the reasons a buyer had in purchasing the property (col. 1, lines 64-67), the Dugan reference does not support the position taken in the Office Action that local neighborhood sales prices are obvious yardsticks for measuring an appraiser's accuracy. Rather, Dugan may be characterized as a warning against simple applications of local sales prices to generate appraisals, as local sales prices may very well be deceptive as a yardstick for valuing other properties. Taking such comments by Dugan at face value, simply using local sales prices as a yardstick to evaluate an appraiser's accuracy as the Final Office Action suggests is neither obvious nor advisable.

Further, while appraisers do have an interest in being accurate, and may use systems such as the Dugan system to improve their accuracy in preparing an appraisal, the purpose of the Dugan system is *not*, as the Final Office Action apparently suggests, to evaluate the performance of an appraiser that uses it. The Dugan system is incapable of doing so.

Indeed, the Dugan system relies on forms completed by the appraiser in use, and has no ability to determine the accuracy of information presented to it or the proficiency of the user.

Because the Dugan system relies on user-completed forms, it is possible, perhaps even probable, that two different appraisers using the Dugan system would receive different appraisals generated by the system. In such a circumstance, would the Dugan system provide any basis to evaluate the appraisers that generated different estimates? The answer is simply no, and this is the question that concerns the subject matter now being claimed. How would someone faced with two different appraisals generated by two different appraisers using the Dugan system decide which appraiser to utilize? Dugan does not answer this question either, but the claimed subject matter does. Even if the same user were to generate two appraisals for the same property using different selections on the Dugan system, would the Dugan system provide any insight to that user which of the appraisals is the most accurate, or even whether either of the two appraisals are accurate? Again, the Dugan system is unhelpful in this regard.

The Dugan system simply provides an appraisal output. It tells you nothing about the appraiser, and is not amenable to comparing multiple appraisers to one another. The Regan reference, also being used by the appraisers themselves, is similar to Dugan in this regard. As such, the art of preparing accurate appraisals, as per the Dugan reference, and the art of evaluating the accuracy of appraisers, as per the invention claimed, does not involve similar problems such that the subject matter of Dugan, because of the subject matter with which it deals, logically would commend itself to the present Applicants' attention in considering the problems before them. See In re Clay, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). Likewise, there is no logical connection between the subject matter claimed and the Regan reference because Regan, as the Final Office Action concedes, is neutral on the issue of categorization of appraisers. Finally, because Regan is silent on the issue, there is no logical connection between the Regan reference and the Dugan reference concerning the subject matter claimed. Neither Regan nor Dugan contemplate the problems posed by the present Applicants, and neither Regan nor Dugan offer a solution to those problems. Applicants therefore maintain their position that a *prima facie* case of obviousness has not been established.

Applicants therefore traverse the position taken that Regan renders the claimed subject matter obvious in view of Dugan. No objective evidence on the record suggests making the combination proposed in the Office Action, nor does anything in the cited references support the notion that a combination of any portion of the Regan and Dugan systems would result in the presently claimed invention. Applicants submit that a rather large gap exists between the

teaching of Regan and Dugan and the subject matter claimed. The Office has not articulated any explicit rational underpinning, supported by *objective* evidence, that the presently claimed subject matter would have been obvious to one of ordinary skill in the art at the time of the invention. Rather, the Office appears to be relying upon subjective supposition and inference that is not reflected in a fair reading of the cited references.

While KSR is discussed at length in the Final Office Action, Applicants wish to note one important aspect of KSR not discussed in the Final Office Action wherein the U.S. Supreme Court cautioned that obviousness conclusions should not rely on *ex post* reasoning. The Supreme Court cautioned that factfinders should resist temptations to read the teaching of an invention into the prior art, and to view the prior art with hindsight in light of the teaching of an invention. That is, the teachings of a patent disclosure should not affect the hypothetical analysis of what a person of ordinary skill, without having the benefit of the patent disclosure, would have done at the time of the invention. Instead, the rejection appears to be based on in impermissible hindsight reconstruction of the invention rather than being based on any contextual reading of the references asserted. In other evidence, while many conclusion of obviousness are presented in the Final Office Action, it is not believed that the cited art provides objective evidence that supports the rejections. As mentioned, some of the rationale behind the rejection appears to be inconsistent with the teaching of the cited art, and Applicants have provided hypothetical analysis that demonstrate that the cited art does not and cannot serve the purposes cited in the Final Office Action.

Applicants respectfully submit that independent claims 1, 7, 11, 16, 26, and 30 are patentable over the cited art. Applicants further submit that the dependent claim 61 is allowable for similar reasons. The reference to claim 2 in the rejection is believed to be in error as claim 2 is no longer pending.

Accordingly, Applicants request that the rejection of claims 1, 2, 7, 11, 16, 26, 30 and 61 be reconsidered and withdrawn.

Claims 3, 4, 8-10, 27, 28, 31, and 32

Claims 3, 4, 8-10, 27, 28, 31, and 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,898,574 to Regan et al. ("Regan") in view of U.S. Patent No. 5,857,174 to Dugan et al. ("Dugan") and further in view of Official Notice. Applicants

disagree, for the reasons stated above, that Regan in view of Dugan establish a *prima facie* case of obviousness of the subject matter recited in the independent claims. Thus, the subject matter recited in dependent claims 3, 4, 8-10, 27, 28, 31, and 32, when considered in combination with the respective independent claims, is patentable over the cited art. For at least these reasons, Applicants request reconsideration and withdrawal of the rejection of claims 3, 4, 8-10, 27, 28, 31, and 32.

Claims 12-14

Claims 12-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,898,574 to Regan et al. ("Regan") in view of U.S. Patent No. 5,857,174 to Dugan et al. ("Dugan") further in view of Official Notice and further in view of U.S. 5,966,699 to Zandi et al. ("Zandi"). Applicants disagree, for the reasons stated above, that Regan in view of Dugan establish a *prima facie* case of obviousness of the subject matter recited in independent claim 11. The Official Notice and Zandi do not cure the deficiencies of Regan and Dugan with respect to independent claim 11. It is therefore submitted that independent claim 11 is patentable over Regan in view of Dugan, Official Notice, and Zandi. Likewise, when the recitations of dependent claims 12-14 are considered in combination with the recitations of independent claim 11, claims 12-14 are also submitted to be patentable over the cited art.

Applicants accordingly submit that the rejection of claims 12-14 should be reconsidered and withdrawn.

Claim 18

Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,898,574 to Regan et al. ("Regan") in view of U.S. Patent No. 5,857,174 to Dugan et al. ("Dugan") and further in view of U.S. Patent No. 6,594,633 to Broerman et al. ("Broerman"). Applicants disagree, for the reasons stated above, that Regan in view of Dugan establish a *prima facie* case of obviousness of the subject matter recited in independent claim 16. The Official Notice and Broerman do not cure the deficiencies of Regan and Dugan with respect to independent claim 11. It is therefore submitted that independent claim 16 is patentable over Regan in view of Dugan, Official Notice, and Broerman. Likewise, when the recitations of

dependent claim 18 is considered in combination with the recitations of independent claim 16, dependent claim 18 is also submitted to be patentable over the cited art.

For at least these reasons, Applicants submit that the rejection of claim 18 should be removed.

Claims 49, 51, 53, 55, 57, and 59

Claims 49, 51, 53, 55, 57, and 59 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,898,574 to Regan et al. ("Regan") in view of U.S. Patent No. 5,857,174 to Dugan et al. ("Dugan") and further in view of the Microsoft Computing Dictionary. Applicants disagree, for the reasons stated above, that Regan in view of Dugan establish a *prima facie* case of obviousness of the subject matter recited in the independent claims. The Microsoft Computing Dictionary does not cure the deficiencies of Regan and Dugan with respect to the independent claims. It is therefore submitted that independent claims are patentable over Regan in view of Dugan, and the Microsoft Computing Dictionary. Likewise, when the recitations of dependent claims 49, 51, 53, 55, 57, and 59 are considered in combination with the recitations of their independent claims, dependent claims 49, 51, 53, 55, 57, and 59 are also submitted to be patentable over the cited art.

Applicants accordingly submit that the rejection of claims 49, 51, 53, 55, 57, and 59 should be reconsidered and withdrawn.

Claims 50, 52, 54, 56, 58, and 60

Claims 50, 52, 54, 56, 58, and 60 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,898,574 to Regan et al. ("Regan") in view of U.S. Patent No. 5,857,174 to Dugan et al. ("Dugan") and further in view of the Microsoft Computing Dictionary. Applicants disagree for the reasons stated above, that Regan in view of Dugan establish a *prima facie* case of obviousness of the subject matter recited in the independent claims. The Microsoft Computing Dictionary does not cure the deficiencies of Regan and Dugan with respect to the independent claims. It is therefore submitted that independent claims are patentable over Regan in view of Dugan, and the Microsoft Computing Dictionary. Likewise, when the recitations of dependent claims 50, 52, 54, 56, 58, and 60 are considered in

combination with the recitations of their independent claims, dependent claims 50, 52, 54, 56, 58, and 60 are also submitted to be patentable over the cited art.

For at least these reasons, Applicants submit that the rejection of claims 50, 52, 54, 56, 58, and 60 should be removed.

Conclusion

It is felt that a full and complete response has been made to the Final Office Action and, as such, the application is in condition for allowance. Such allowance is hereby respectfully requested.

Although the prior art made of record and not relied upon may be considered pertinent to the disclosure, none of these references anticipates or makes obvious the recited aspects of the invention. The fact that Applicants may not have specifically traversed any particular assertion by the Office should not be construed as indicating Applicants' agreement therewith.

Applicants wish to expedite prosecution of this application. If the Examiner deems the application to not be in condition for allowance, Applicants request that the Examiner telephone the undersigned to discuss advancing prosecution of the present application in a timely manner.

Respectfully submitted,

Daniel M. Fitzgerald, Reg. No. 38,880
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070